



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,884	08/27/2007	Karl G. Csaky	NIHA 0383	8820
45160	7590	04/07/2011	EXAMINER	
OTT- NIH c/o WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			AUDET, MAURY A	
			ART UNIT	PAPER NUMBER
			1654	
			NOTIFICATION DATE	DELIVERY MODE
			04/07/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

coffice@woodcock.com

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/588,884	Applicant(s) CSAKY ET AL.
	Examiner MAURY AUDET	Art Unit 1654

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 February 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 112 2nd/112 1st.
6. ☒ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: 20-26 and 30-42.
Claim(s) rejected: 1-19.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Maury Audet/
Primary Examiner, Art Unit 1654

Continuation of 11. does NOT place the application in condition for allowance because:

I. Allowability of Claims 20-26 and 30-42, As Indicated in Last Office Action

As noted previously, compositions comprising SEQ ID NOS: 1-5 were not found to be reasonably taught or suggested by the prior art of record, based on the ABSS sequence search of the relevant databases for SEQ ID NOS: 1-5, upon addressing the above.

II. Allowability of Claims 20-26 and 30-42, but for Minor Claim Objections

Claims 20-26 and 30-42 are in condition for allowance as not being reasonably taught or suggested by the prior art of record, but for a few minor objections noticed by the Examiner, but not previously observed:

i) in claims 20, 21, 26 the term "an" should be deleted and replaced with the term --the-- per Office policy on peptides, as was done in claims 34-42 (otherwise technically the claims could be drawn to 'an' amino acid sequence within e.g. SEQ ID NO: 1); and

ii) in claims 21 and 26, after the term "sequence", the accepted Markush type phrase should be inserted --selected from the group consisting of--.

NOTE: The Examiner telephoned Applicant regarding an Examiner's Amendment to correct the above. However, this became a moot issue, as Applicant requested rejoinder of all method claims which require further action on the merits to substantively address 35 USC 112 1st Enablement issues, see below.

III. 35 USC 112 1st Enablement Rejection over Rejoined Claims 1-19

The Examiner telephoned on 3/25/11 Applicant's Representative, Jane Inglese, inquiring as to whether Applicant wanted rejoinder of claims 1-19 under *In re Ochiai*, or to cancel without prejudice these claims and accept the allowability of claims 20-26 and 30-42 (once the objection noted above was addressed). The Examiner indicated at the time that the rejoined claims would be subject to issues/search relevant to 35 USC 112 1st Enablement, which would require further prosecution/examination on the merits.

Applicant's Representative requested on behalf of Applicant, that withdrawn claims 1-19 be rejoined, per *In re Ochiai*. As the rejoined claims raise new issues (35 USC 112 1st Enablement) that would require further consideration and/or search as to treating ANY condition associated with ocular neovascularization (see claims 1-2) or treating ANY cancer (see claims 13-14).

[e.g. No different than section 3.(a) above, under "Amendments", as if claims 20-26 and 30-42, which were under examination, had been amended in such a way as to raise a new issue(s) such as 35 USC 112 1st Enablement., which would require further consideration].

Thus, since enablement was not at issue as to the elected products and a search of the art to provide references that NO peptide is capable of treating ANY cancer and/or ANY condition "associated with" (however loosely) to ocular neovascularization; then addressing these issues and conducting that search both require further consideration that must be addressed at a later stage (e.g. continuation, RCE) since the present application is now After Final.